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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,398	12/19/2001	Michael L. White	5058US (01-01-132)	2055

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BRYAN W. BOCKHOP, ESQ.
ARANLL GOLDEN GREGORY LLP
2800 ONE ATLANTA CENTER
1201 WEST PEACHTREE STREET
ATLANTA, GA 30309-3450

EXAMINER	
CAPRON, AARON J	

ART UNIT	PAPER NUMBER
3714	17

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/029,398	WHITE, MICHAEL L.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *39-42,51-54 and 60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *39-42, 51-54 and 60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is a response to the Amendment received on March 8, 2004, in which claims 39 and 51 were amended, claim 60 was added, and claims 36-38, 43-50 and 55-59 were cancelled. Claims 39-42, 51-54 and 60 are pending.

Applicant's after final Amendment of March 8, 2004 has been entered and prosecution has been re-opened in order to consider the following new grounds of rejection.

Claim Objections

Referring to claims 40-42, the Applicant may want to consider revising the claim language since portions of the dependent claims 40-42 have been iterated in their independent claim 39. For example, regarding claim 40, consider "...wherein the set of game elements are arranged in matrix form, ~~comprising: determining...~~and the closeness of the game elements to the winning game elements...

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 39, the claims are indefinite since "one of the game elements" and "the set of game elements" do not have the proper antecedent basis.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-42, 51-54 and 60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete and tangible result.

[Technological Arts Analysis]

For a claimed invention to be statutory, the claimed invention must be directed to a practical application within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, the claims merely recite a method for determining the closeness of game elements for two players. The invention, as claimed and disclosed, merely involves the manipulation of abstract concepts (e.g. a persons background, weight numbers, subjective assigned values, etc.) in a computer or a person's mind that does not involve the use of anything

in the technological arts. The invention involves nothing more than a computer or a human making computations and recording the results of these computations.

[Useful, Concrete and Tangible Analysis]

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. See, e.g., *State Street Bank and Trust Co. v. Signature Financial Group Inc., 149 F.3d at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998).* A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerman, 33F.3d 1354, 1360, 31 USPQQ2d 1754, 1759 (Fed Cir. 1994).*

In the present case, the claims do not produce a concrete or tangible result. The claims merely recite a method for determining the closeness of game elements for two players and determining a payout according to the game outcome. The mere determining of a game outcome does not provide a concrete or tangible result. In order to overcome the rejection above, the claimed invention must award a payout, according to the game outcome, to a player having a game element that is physically or mathematically closer.

Allowable Subject Matter

Claims 39-42, 51-54 and 60 are rejected based upon the issues stated above but would be allowable if rewritten to exclude the rejections stated above.

The following is an examiner's statement of reasons for conditions for allowance:

While the prior art reference of record provides a keno gaming method comprising determining a plurality of players making wagers, determining the plurality of players selecting game elements, determining a game closeness based upon the selected game elements and

determining a payout. However, the prior art fails to teach, disclose or suggest a keno gaming method that defines closeness the closeness between two players selection of game elements as being mathematical closeness or physical closeness that as claimed in Applicants' invention. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

JESSICA HARRISON
PRIMARY EXAMINER